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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,116	10/22/2001	David Sauer	IP1-0106	5698

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EXAMINER

GENACK, MATTHEW W

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/037,116

**Applicant(s)**

SAUER ET AL.

**Examiner**

Matthew W. Genack

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 58-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 58 and 62-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilk, U.S. Patent No. 6,768,789.

Regarding Claims 58 and 69, Wilk discloses a method and device for telephone call answering by a callee (Abstract, Column 1 Lines 6-10, Column 2 Lines 14-17).

Specifically, the callee has a wireless telephone with a memory (Column 3 Lines 30-35, Fig. 1). Said wireless telephone memory stores a plurality of predefined outgoing messages (by inherency, each outgoing message will be associated with a binary number identifier) (Column 3 Lines 30-41, Column 4 Lines 10-30). The predefined messages may be provided in a plurality of languages (by inherency, each language offered will be associated with a binary number identifier) (Column 7 Lines 24-30). The callee selects a particular outgoing message and plays the selected message for the caller (who may also be using a wireless telephone) (Column 5 Lines 49-62, Fig. 2).

Regarding Claims 62-68 and 70, Wilk discloses the storage of customizable concatenated outgoing messages by the wireless telephone, said messages having

predefined portions, as well as customizable portions that may be entered as text with the use of the wireless telephone's keypad, and that may incorporate time information (Column 4 Line 10 to Column 5 Line 4, Column 6 Lines 13-20).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 61 and 72-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Enns *et. al.*, U.S. Patent Application Publication 2002/0116499.

Regarding Claims 72 and 78, Wilk discloses a method and device for telephone call answering by a callee (Abstract, Column 1 Lines 6-10, Column 2 Lines 14-17). Specifically, the callee has a wireless telephone with a memory (Column 3 Lines 30-35, Fig. 1). Said wireless telephone memory stores a plurality of predefined outgoing messages (by inherency, each outgoing message will be associated with a binary number identifier) (Column 3 Lines 30-41, Column 4 Lines 10-30). The predefined messages may be provided in a plurality of languages (by inherency, each language offered will be associated with a binary number identifier) (Column 7 Lines 24-30). The callee selects a particular outgoing message and plays the selected message for the caller (who may also be using a wireless telephone) (Column 5 Lines 49-62, Fig. 2). The wireless telephone comprises a processor and a keypad (Column 3 Lines 30-35, Column 5 Lines 1-4). By inherency, the wireless telephone comprises a transceiver. A

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network server receives the message and forwards said message to the recipient (Column 3 Lines 18-20).

Wilk does not expressly disclose the storage recipient contact information in the memory of the wireless telephone for the purpose of sending the predefined message (since the predefined messages are sent back to the party that initiated the call).

Enns *et. al.* discloses a method and device for sending a message from a mobile device to specified recipients, said recipients being in a list stored in said mobile device (Abstract, [0004], [0017], [0019], [0059], Figs. 1 and 6).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Wilk by including a list of contacts in the wireless telephone and enabling the transmission of a message to one or more contacts on said list.

One of ordinary skill in the art would have been motivated to make this modification because contact lists allow quick and easy communication with one or more individuals.

The rejection of Claim 61 is parallel to that of Claims 72 and 78.

Regarding Claims 73-76 and 79-82, Wilk discloses the storage of customizable concatenated outgoing messages by the wireless telephone, said messages having predefined portions, as well as customizable portions that may be entered as text with the use of the wireless telephone's keypad, and that may incorporate time information (Column 4 Line 10 to Column 5 Line 4, Column 6 Lines 13-20).

Regarding Claim 77, the wireless telephone's interface may be used to select a preferred message language (by inherency, each language offered will be associated with a binary number identifier) (Column 7 Lines 24-30).

5. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Godoroia, U.S. Patent No. 5,663,715.

Wilk does not expressly disclose the storage of predefined messages in the memory of the recipient telephone, each predefined message associated with a respective code that said recipient telephone may receive from the transmitting telephone.

Godoroia discloses the decoding of a predefined message by a recipient wireless device (Column 2 Lines 32-34, Column 9 Lines 51-54).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Wilk by providing for the storage of predefined messages in the memory of the recipient telephone, each predefined message associated with a respective code that said recipient telephone may receive from the transmitting telephone.

One of ordinary skill in the art would have been motivated to make this modification in order to reduce the amount of time and bandwidth required to transmit a message.

6. Claims 60 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Mahr, U.S. Patent No. 6,956,831.

Wilk discloses that a network server receives the message and forwards said message to the recipient (Column 3 Lines 18-20).

Wilk does not expressly disclose the construction of a text message, by the server, from codes that are transmitted from the sending wireless telephone.

Mahr discloses a wireless messaging system comprising a personalized message database and a call control center; in response to the reception of a signal (containing a predefined message initiation code and an identifier of the receiving station) from a wireless subscriber, the call control center retrieves the predefined message and transmits said predefined message to the intended receiving station (Abstract, Column 5 Lines 25-58, Fig. 1).

At the time that the invention was made, it would have been obvious to one of ordinary skill in the art to modify the invention of Wilk by providing the server with the ability to construct a text message from a code transmitted by a wireless user, and to send said message to the intended recipient.

One of ordinary skill in the art would have been motivated to make this modification in order to provide a wireless user with the ability to transmit personalized non-MO (mobile originated) predefined messages (Mahr: Column 2 Lines 34-56).

7. Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk in view of Enns *et. al.*, further in view of Mahr.

The rejection of Claim 83 is parallel to that of Claims 60 and 71.

### ***Response to Arguments***

8. Applicant's arguments with respect to Claims 58-83 have been considered but are moot in view of the new grounds of rejection necessitated by Applicants amendments, filed 20 July 2006.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew W. Genack whose telephone number is 571-272-7541. The examiner can normally be reached on FLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-7541.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Matthew Genack

Examiner

TC-2600, Division 2617



20 September 2006



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